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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,004	12/05/2001	Christian Struble	10015512-1	2849

7590 01/26/2006  
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EXAMINER

DIVINE, LUCAS

ART UNIT PAPER NUMBER

2624

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/002,004	Applicant(s) STRUBLE, CHRISTIAN	
	Examiner Lucas Divine	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,19-21 and 23-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13,19-21 and 23-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1 – 4, 6 – 13, 19 – 21 and 23 – 25 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 10/24/05 have been fully considered but they are not persuasive.

With respect to applicant's arguments that Yoshida doesn't teach that the information retrieved is 'pertaining to the imaging apparatus'.

In reply, Yoshida teaches that the information retrieved is what functions of other devices are usable/accessible to the immediate apparatus. Thus, the information retrieved pertains to what the apparatus can access. Thus, the rejection is maintained.

3. Applicant's arguments with respect to Arima have been considered but are moot in view of the new ground(s) of rejection. The features of the amended claims 1 and 19 that are not specifically discussed in Arima are discussed in Hayward as cited below. Thus, the amendment necessitates the new grounds of rejection and the arguments are moot.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 9, 10, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. (US 6130757).

Regarding claim 9, Yoshida teaches **an imaging apparatus** (1, 4, or 6, Fig. 2)

**comprising:**

**a user display** (touch screen of Fig. 15 is a user display and a user input, shown in other figures) **configured to present to a user a plurality of retrievable information types** (e.g. TP6 of Fig. 15), **each information type associated with information pertaining to the imaging apparatus** (the information type [e.g. staple] is used to search the network for information pertaining to what the local imaging apparatus can access and utilize – Fig. 1 also shows further information pertaining to the imaging apparatus as accessible and ultizable in the bubble in the upper right);

**a user input** (user input OP shown in the figures [e.g. Fig. 3], which includes the touch screen 91; col. 6 lines 43-46; col. 9 lines 11-13) **to allow the user to select at least one of the retrievable information types** (Fig. 15 shows the user being able to select functions to search for and then they are placed in TP7) **and to generate an associated information retrieval signal in response thereto** (TP8, Fig. 15 shows the button that causes an information retrieval signal sent to the processors to do the search of the network for the asked for information associated with the information types selected);

**a communication device (50 as controlled by CPU 103, Fig. 2 & 4) connectable to an information network (LAN and PSTN of Fig. 1 is accessed by 50 in Fig. 2 & 4; col. 4 lines 21-23); and**

**a controller (Fig. 4 shows many controllers [CPUs, e.g. 101-106] for controlling various parts of the imaging apparatus, as a group, they work to control all functions of the device and act as a single device controller called CONT [Fig. 2, col. 7 lines 1-5]) configured to receive the information retrieval signal (CPU 101 controls the operation panel, which receives the signals from the operator panel; col. 7 lines 12-18, col. 12 lines 35-65) and, in response thereto, to use the communication device to retrieve from the information network the associated information pertaining to the imaging apparatus (CPU 103 controls the network input/output unit 53 [col. 7 lines 23-35]; col. 6 lines 5-19; Fig. 21 and 22 show the network interactions for retrieving the information as selected by the user – see *col. 12 line 20 – col. 17 line 5*, specifically col. 12 lines 54-57).**

Regarding claim 10, which depends from claim 9, Yoshida teaches

**a memory device (RAMs 121-126 and ROMs 111-116) containing an information retrieval program (col. 2 line 64, col. 7 lines 4-11, wherein the operation of the CPUs are based on programs stored in RAMs 121-126 and ROMs 111-116); and**

**wherein the information retrieval program comprises a series of computer executable instructions configured to be executed by the controller (programs inherently have instructions and are executed by controllers) to cause the controller to use the communication device to retrieve from the information network the associated information pertaining to the imaging apparatus (CPU 103 [through programs in its ROM 103 and RAM**

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113] controls the network input/output unit 53 [col. 7 lines 23-35]; col. 6 lines 5-19; Fig. 21 and 22 show the network interactions for retrieving the information as selected by the user – see *col. 12 line 20 – col. 17 line 5*, specifically col. 12 lines 54-57).

Regarding claims 1, 4, the structural elements of apparatus claims 9 and 10 are the same as those claimed in apparatus claims 1, 4. For example, the user input to generate an information retrieval signal, a communication device, a processor/controller, and a memory device are all claimed and taught by the imaging apparatus of Yoshida. Therefore, claims 1 and 4 are rejected for the same reasons as stated above in the rejection of apparatus claims 9 and 10. Also, the display of Yoshida shows that the selections are through a **menu** in Fig. 15 as recited the rejection of claim 9. Therefore, method claims 19 and 22 are rejected for the same reasons set forth in the rejection of apparatus claim 9.

Regarding claim 19, the structural elements of apparatus claim 9 perform all of the method steps of method claims 19. For example, using the communication device to retrieve information in claim 9 performs the method step of using the signal to initiate a communication session with an information network of claim 19. Also, the display of Yoshida shows that the selections are through a **menu** in Fig. 15 as recited the rejection of claim 9. Therefore, method claim 19 is rejected for the same reasons set forth in the rejection of apparatus claim 9.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 9 above, and further in view of Masuda et al. (US 2001/0008997).

Regarding claim 11, which depends from claim 9, Yoshida teaches to display the retrieved information (Fig. 16, col. 15 lines 29-31). Yoshida can also access information and retrieve it from server PC 3 (col. 4 lines 30-32). Yoshida also request information from remote servers (see step S15 of Fig. 21) and this information can be useful information to the user (col. 14 lines 55-60, wherein telephone number information for faxing is a type of information that can be requested). Also, Fig. 1 shows that "others" types of information can be retrieved from the network. These facts and the fact that a user clearly wishes to know the information and has it displayed, would lead to the motivation that they may want to also print the information for their own records (for example, printing the phone number information to save for a later date). Reasons for printing desired information are also very well known in the art. Further, Yoshida teaches that the client that is doing the information requesting is a copying machine with a PRINTING unit (Fig. 2, PRT). Therefore, the motivation for being able to print desired information is clearly put forth in the reference of Yoshida, but the actual statement of printing the retrieved information is not expressly stated.

However, in paragraph 61, Masuda teaches selecting whether to display or print information in display device 16, which includes a display and a printer (Fig. 1).

Therefore it would have been obvious to one of ordinary skill in the art to allow the user to display or print the searched for desired information. The motivations for doing so are discussed above in the Yoshida discussion.

6. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 9 above, and further in view of Hayward et al. (US 6629134).

Regarding claims 12 and 13, which depend from claim 9, Yoshida teaches **the memory device contains a plurality of network locators** (Yoshida a system where other devices are specifically accessed to retrieve information associated with information types selected. By accessing specific devices to learn their information (Fig. 13, where 3F, 2F, 1F, 2F, 1F are examples of specific machines accessed), the network addresses of the devices must be known and stored in memory (RAMs 121-126 and ROMs 111-116 are memory devices of Yoshida). For example, col. 12 line 56 teaches requesting the other server terminals specifically for their functions, which must be done with network locators), **and wherein each of the plurality of retrievable information types has an associated one of the network locators** (Fig. 16, the user has searched for the types in TP7 of Fig. 15 and has retrieved the devices that have those functions, therefore each of the three types are at least each associated with the device [and its identifier], if other types would have been searched, associated devices [and their identifiers] would have been identified to the user).

Yoshida also teaches that the imaging apparatus can also act as a **server** (col. 4 lines 30-42, col. 9 lines 15-16). Thus the communication device (CPU 103 and input/output controlling unit 50) performs the server related functions and thus the **communication device is a server**.

In regards to URL's and web server, Yoshida teaches the accessing of fax, LAN, and the telephone networks (col. 8 lines 47-60). Yoshida does not specifically teach that the networks accessed are the Internet or World Wide Web, which use URLs.



However, Hayward specifically teaches accessing the **web** (Fig. 2, Internet 36) for information pertaining to an imaging apparatus (Fig. 3 shows information types), which must include URLs in a web environment (col. 1 lines 25-30; col. 2 lines 20-40, wherein specific URLs are accessed based on printer conditions or selections by a user).

It would have been obvious to one of ordinary skill in the art that the networks of Yoshida could include the Internet (and associated URLs). The motivation for doing so would have been to allow the search of many more devices etcetera. Motivations for web use are well known in the art. Further, Hayward teaches accessing the Internet through modem 34, and since Yoshida accesses phone networks already, no functional changes would have been necessary.

7. Claims 1 – 4, 6 – 8, 19, 20, and 23 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arima (US 6714744) and Hayward et al. (US 6629134).

Regarding claim 1, Arima teaches a **system to retrieve information pertaining to an imaging apparatus** (Fig. 18, wherein it would have been obvious to include the searching for best prices etc. of embodiment of Fig. 18 with the ordering steps of the embodiment of Fig. 14), **comprising:**

**an imaging apparatus** (e.g. Fig 18, everything but 15B and 18C) **comprising an information retrieval signal generator** (detection unit 18B [col. 8 lines 37-51 detects conditions, Fig. 20 S2002] and search unit 18A [take condition and generate search instruction, col. 8 lines 55-59] combine and work with CPU 1A, memory 1B, and UI 1D, 7A to act as a condition detector to generate a search instruction as an information retrieval signal), **the information signal generator including a user interface** (1D, 7A, wherein in Fig. 15 the user

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can click a button of whether or not to order in the UI which will can start the searching for best price and ordering processes, see also Figs. 16, 17);

**a communication device (communication unit 15A) connectable to an information network** (jagged line shown in Fig. 18, Internet discussed col. 10 line 36 and throughout);

**a processor (CPU 1A) configured to execute a series of computer executable instructions** (CPU controls the computer components of Fig. 18, thus executing instructions to control them); **and**

**a memory device (1B, Fig. 18) containing an information retrieval program comprising a series of computer executable instructions** (printing apparatus memory inherently store the programs that are run on the device – controller runs the information retrieval program shown in Fig. 20 and discussed in the rejection of claim 14) **and, in response thereto, to retrieve from the information network, via the communication device, information pertaining to the imaging apparatus** (communication unit 15A retrieves searched information stored in provider 15B after the provider searches for information pertaining to what the correct consumables that the apparatus can and should order for replenishment, col. 10 line 50 – col. 11 line 25).

While Arima teaches a user using a user interface to search for and order consumables when the consumables are low based on user input, Arima does specifically teach a whole menu on the user interface including receiving a user input in a menu.

However, Hayward specifically teaches a similar system to that of Arima including sensing a low level of consumable and allowing a user via a user interface to order consumables (see Figs. 3 – 7, menu specifically shown in Fig. 3).

Since Arima is primarily concerned with consumables, Arima does not discuss the other types of things that would be obvious to include on a user interface in a menu such as that of Hayward. Thus, it would have been obvious to combine the menu of Hayward to the printing system of Arima. The motivation for doing so would have been to provide the user many more options for easily and quickly understanding and controlling printer operations.

Regarding claim 2, which depends from claim 1, Arima teaches **a series of computer executable instructions to print the information** (col. 7 lines 52-58 teaches [applicable to all expendable ordering embodiments including embodiment 2] that a FAX form and/or mail form may be displayed with the searched information for placing an order and that an order may be placed to a retailer via FAX or mail; the only way to do so would be to have a printout by the print unit 1C; thus, this feature is inherent to Arima).

Regarding claim 3, which depends from claim 1, Arima teaches **a series of computer executable instructions to store the information in the memory device** (col. 6 line 8, wherein the memory 1B can store retailer information).

Regarding claim 4, which depends from claim 1, Arima teaches the **communication device, the processor, and the memory are all resident within the imaging apparatus** (Fig. 18).

Regarding claim 6, which depends from claim 1, Arima teaches **a condition detector (18B) coupled to the information retrieval signal generator** (coupled to 18A via line in Fig. 18).

Regarding claim 7, which depends from claim 6, Arima teaches **imaging apparatus is configured to image sheets of media** (prints on paper 19A), and further wherein the

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**condition detector comprises a sheet counter (Fig. 2 [and its description – counter N counts down], Fig. 3 - Fig. 20, step 2002, wherein expendables are ink, paper, and/or photosensitive body) configured to count sheets of media imaged by the imaging apparatus (Fig. 2, Fig. 3).**

Regarding claim 8, which depends from claim 6, Arima teaches **imaging apparatus is configured to image sheets of media using an imaging substance (ink 19A is used to print on paper 19B), and further wherein the condition detector is configured to detect a quantity of imaging substance (Fig. 20, step 2002, wherein expendables are ink, paper, and/or photosensitive body) used by the imaging apparatus to image sheets of media (ink 19B is used to print on paper 19A).**

Regarding claim 19, the structural elements of apparatus claim 1 perform all of the method steps of claim 19, which is therefore rejected for the reasons set forth in the rejection to claim 1.

Regarding claim 20, which depends from claim 19, the structural elements of apparatus claim 2 perform all of the method steps of method claim 20. Therefore method claim 20 is rejected for the same reasons set forth in the rejection of apparatus claim 2.

Regarding claim 23, which depends from claim 19, the structural elements of apparatus claim 6 perform all of the method steps of method claim 23. Therefore method claim 23 is rejected for the same reasons set forth in the rejection of apparatus claim 6. Also, the detection of the low consumable as an example is what causes the information retrieval signal.

Regarding claim 24, which depends from claim 23, the structural elements of apparatus claim 7 perform all of the method steps of method claim 24. Therefore method claim 24 is rejected for the same reasons set forth in the rejection of apparatus claim 7.

Regarding claim 25, which depends from claim 23, the structural elements of apparatus claim 7 perform all of the method steps of method claim 25. For example, imaging media are the sheets used. Therefore method claim 25 is rejected for the same reasons set forth in the rejection of apparatus claim 7.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arima and Hayward as applied to claim 19 above, and further in view of Kumada (US 6563944).

Regarding claim 21, which depends from claim 19, while Arima teaches  
**the imaging apparatus is a first imaging apparatus (Fig. 18 shows the first and only printing apparatus specifically discussed), and**  
**the controller is further configured to print the information associated with the detected condition using the first imaging apparatus (see rejection of claim 16).**  
**displaying the information via a user display (Fig. 21B), and**  
**saving the information to a memory location (col. 6 line 8, wherein the memory 1B can store retailer information, which is what is searched for in embodiment 2).**

Arima does not specifically teach printing on a first printer when possible and if not, allowing the user to select what to do, including the option of directing printing to another printer.

Kumada teaches an image processing apparatus and method that automatically selects a substitute output device including printing on a first printer when possible (Fig. 8, step 108), and if not, allowing the user to select what to do (Fig. 9, Fig. 8 step 104), including the option of directing printing to another printer (Fig. 8 steps S105-S106).

It would have been obvious to one of ordinary skill in the art that if the apparatus of Arima couldn't print (because possibly the expendable ink is out), to let the user chose what to do next, including the option to direct the mail/FAX order form to a substitute printer. The motivation for allowing the user to do what they like (be it save the data, display it, or print it elsewhere) would allow the system to respond better to user needs. There are plenty of possible example when a user would like to do any of these options, and they will not all be recited here, only one example for each. For saving the data: the user would like the data to print out later on the current printer. For displaying the data: the user can't get to an alternate printer and will just copy down the information or memorize it or show it to someone else. For printing on another printer: to perform the mail/FAX orders even if the local printer can't perform the print, wherein if no alternate printer was selected, the user couldn't perform the mail/FAX order.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lucas Divine  
Examiner  
Art Unit 2624

**KING Y. POON  
PRIMARY EXAMINER**

ljd